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10/588,131	04/16/2007	Gad Terliuc	4529/97913	3855

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,131	Applicant(s) TERLIUC, GAD	
	Examiner MATTHEW J. KASZTEJNA	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 170-198 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 170-198 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/18/9, 6/18/8, 5/5/8, 7/6/7</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 170-171, 175-178, 180-181 and 188-194 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 199-205 of copending Application No. 11/980025 to Teriluc. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are merely broader in scope than those of copending Application No. 11/980025 to Teriluc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 170-175, 177-185, 188-194 and 197-198 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,983,165 to Loiterman.

In regard to claim 170, Loiterman discloses an endoscope assembly comprising: an endoscope head extending along a longitudinal axis and having a first plurality of selectably radially extendible elements 4 associated therewith at at least one first axial location therealong and a second plurality of selectably radially extendible elements 5 associated therewith at at least one second axial location therealong (see Fig. 1); and an endoscope head controller 14 being operative for controlling selectable extension of said first and second pluralities of selectably radially extendible elements for selectable positioning of said endoscope head (see Col. 4, Lines 8-34).

In regard to claim 171, Loiterman discloses an endoscope assembly, wherein said endoscope head controller is operative for controlling selectable extension of said first and second pluralities of selectably radially extendible elements for selectable parallel off-center orientation of said endoscope head (see Figs. 4-6 and Col. 4, Lines 8-34). It is noted that the words “*operative for*” in the claim may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the

intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

In regard to claims 172-173, Loiterman discloses an endoscope assembly, wherein said endoscope head controller is operative for controlling selectable extension of said first and second pluralities of selectably radially extendible elements for selectable tilted orientation of said endoscope head (see Figs. 4-6 and Col. 4, Lines 8-34).

In regard to claim 174, Loiterman discloses an endoscope assembly, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of radially extendible elements distributed generally azimuthally about said endoscope head (see Figs. 2-3 and Col. 3, Lines 48-57).

In regard to claim 175, Loiterman discloses an endoscope assembly, wherein said endoscope head comprises a locomotive endoscope head (see Fig. 1)

In regard to claim 177, Loiterman discloses an endoscope assembly, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of selectably inflatable balloons (see Figs. 2-3 and Col. 3, Lines 48-57).

In regard to claim 178, Loiterman discloses an endoscope assembly, also comprising an endoscope body 1 associated with said endoscope head and an instrument channel 9 at least partially extending through said endoscope head and said endoscope body (see Col. 3, Lines 41-47).

In regard to claim 179, Loiterman discloses an endoscope assembly, wherein said endoscope head has a fixed length (see Fig. 1).

In regard to claim 180, Loiterman discloses an endoscope assembly, and wherein said endoscope body interfaces with said endoscope head controller and also comprising an endoscopy system 10, 13, 14 to which said endoscope head controller is connectable (see Fig. 1 and Col. 4, Lines 5-20).

In regard to claim 181, Loiterman discloses an endoscope assembly, wherein said endoscope body includes at least one lumen 7 operative for extension of said radially extendible elements (see Col. 4, Lines 8-10).

In regard to claim 182, Loiterman discloses an endoscope assembly, wherein said first plurality of selectably radially extendible elements comprises at least two independently selectably radially extendible elements (see Figs. 4-6 and Col. 4, Lines 8-34).

In regard to claims 183-184, Loiterman discloses an endoscope assembly, wherein said second plurality of selectably radially extendible elements comprises at least two independently selectably radially extendible elements (see Figs. 4-6 and Col. 4, Lines 8-34).

In regard to claim 185, Loiterman discloses an endoscope assembly, wherein said at least two independently selectably radially extendible elements of said second plurality of selectably radially extendible elements are azimuthally offset with respect to said at least two independently selectably radially extendible elements of said first plurality of selectably radially extendible elements (see Col. 4, Lines 48-50).

In regard to claims 188-190, Loiterman discloses an endoscope assembly, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of selectably inflatable balloons (see Figs. 4-6 and Col. 3, Lines 49-56).

In regard to claims 191-194, Loiterman discloses an endoscope assembly, wherein said at least two independently selectably radially extendible elements comprise at least two independently selectably inflatable balloons (see Figs. 4-6 and Col. 3, Lines 49-56).

In regard to claim 197, Loiterman discloses an endoscope positioning method comprising: providing an endoscope head extending along a longitudinal axis and having a first plurality of selectably radially extendible elements 4 associated therewith at at least a first axial location therealong and a second plurality of selectably radially extendible elements 5 associated therewith at at least a second axial location therealong; and selectably positioning said endoscope head by selectable extension of said first and second pluralities of selectably radially extendible elements (see Figs. 4-6 and Col. 4, Lines 8-34).

In regard to claim 198, Loiterman discloses an endoscope positioning method, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of radially extendible elements distributed azimuthally about said endoscope head and said positioning said endoscope head includes selectable extension of individual ones of said plurality of radially extendible elements (see Figs. 2-3 and Col. 3, Lines 48-57).

Claims 170, 174-184, 186-187, 191-193 and 195-198 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,040,413 to Ohshiro.

In regard to claims 170, Ohshiro discloses an endoscope assembly comprising: an endoscope head extending along a longitudinal axis and having a first plurality of selectably radially extendible elements 52a-b associated therewith at at least one first axial location therealong and a second plurality of selectably radially extendible elements 54a-b associated therewith at at least one second axial location therealong (see Fig. 5-6); and an endoscope head controller being operative for controlling selectable extension of said first and second pluralities of selectably radially extendible elements for selectable positioning of said endoscope head (see Col. 4, Lines 18-65).

In regard to claim 174, Ohshiro discloses an endoscope assembly, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of radially extendible elements distributed generally azimuthally about said endoscope head (see Figs. 5-6).

In regard to claims 175-176, 186-187 and 195-196, Ohshiro discloses an endoscope assembly wherein when the endoscope is inserted in a body cavity, the balloons 52a and 52b of the inner sleeve 51 and the balloons 54a and 54b of the outer sleeve 53 are alternately inflated and deflated and the inner sleeve 51 and the outer sleeve 53 are alternately advanced into the body cavity 56. The inner sleeve 51 with deflated balloons 52a and 52b is first inserted into the body cavity 56 up to a position to which the inner sleeve 51 can be inserted comparatively easily. Then, the balloons 52a and 52b provided on the inner sleeve 51 are inflated simultaneously to enlarge the

space in the body cavity 56 therearound as shown in FIG. 5. Thus, the insertion of the outer sleeve 53 into the body cavity 56 is facilitated. After the outer sleeve 53 with deflated balloons 54a and 54b has been inserted into the body cavity 56, the balloons 54a and 54b are inflated simultaneously to enlarge the space therearound and the balloons 52a and 52b on the inner sleeve 51 are deflated as shown in FIG. 6. Then, the inner sleeve 51 is further advanced into a deeper part of the body cavity 56. By repeating the above steps, the endoscope can easily be inserted deeply in the body cavity without pain (see Col. 4, Lines 18-65).

In regard to claim 177, Ohshiro discloses an endoscope assembly, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of selectably inflatable balloons (see Figs. 5-6 and Col. 4, Lines 13-25).

In regard to claim 178, Ohshiro discloses an endoscope assembly, also comprising an endoscope body associated with said endoscope head and an instrument channel 51a, 55a-b at least partially extending through said endoscope head and said endoscope body (see Figs. 5-6).

In regard to claim 179, Ohshiro discloses an endoscope assembly, wherein said endoscope head has a fixed length (see Figs. 5-6).

In regard to claim 180, Ohshiro discloses an endoscope assembly, and wherein said endoscope body interfaces with said endoscope head controller and also comprising an endoscopy system to which said endoscope head controller is connectable (see Col. 4, Lines 18-65).

In regard to claim 181, Ohshiro discloses an endoscope assembly, wherein said endoscope body includes at least one lumen 55a-b operative for extension of said radially extendible elements (see Figs. 5-6).

In regard to claim 182, Ohshiro discloses an endoscope assembly, wherein said first plurality of selectably radially extendible elements comprises at least two independently selectably radially extendible elements (see Col. 4, Lines 33-34).

In regard to claims 183-184, Ohshiro discloses an endoscope assembly, wherein said second plurality of selectably radially extendible elements comprises at least two independently selectably radially extendible elements (see Col. 4, Lines 33-34).

In regard to claims 191-193, Ohshiro discloses an endoscope assembly, wherein said at least two independently selectably radially extendible elements comprise at least two independently selectably inflatable balloons (see Col. 4, Lines 33-34).

In regard to claim 197, Ohshiro discloses an endoscope positioning method comprising: providing an endoscope head extending along a longitudinal axis and having a first plurality of selectably radially extendible elements 52a-b associated therewith at at least a first axial location therealong and a second plurality of selectably radially extendible elements 54a-b associated therewith at at least a second axial location therealong; and selectably positioning said endoscope head by selectable extension of said first and second pluralities of selectably radially extendible elements (see Figs. 5-6 and Col. 4, Lines 18-65).

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In regard to claim 198, Ohshiro discloses an endoscope positioning method, wherein at least one of said first and second pluralities of selectably radially extendible elements comprises a plurality of radially extendible elements distributed azimuthally about said endoscope head and said positioning said endoscope head includes selectable extension of individual ones of said plurality of radially extendible elements (see Col. 4, Lines 33-34).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/
Primary Examiner, Art Unit 3739

10/8/09